

REMARKS

I. INTRODUCTION

Claims 1, 8, 16, 23, 26, 30 and 38 have been amended to clarify and broaden the exemplary claimed subject matter of the present application. New claims 45-53 have been added. Accordingly, claims 1-53 are now under consideration in the above-referenced application. Provided above, please find a claim listing indicating the current amendments to claims 1, 8, 16, 23, 26, 30 and 38, and the addition of new claims 45-53. Applicants respectfully assert that the amendments to the claims and the additional new claims fully comply with the requirements set forth in 37 C.F.R. § 1.121. Support for the claim amendments and new claims can be found, e.g., in the specification and drawings. (See, e.g., specification, page 2, lines 17-24; page 3, lines 1-6; page 6, lines 7-16; page 19, lines 3-8; and Figure 6). It is respectfully submitted that no new matter has been added.

II. REJECTION UNDER 35 U.S.C. § 103(a) SHOULD BE WITHDRAWN

Claims 1-44 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,877,093 issued to Desai et al. (the “Desai patent”), in view of either U.S. Patent No. 6,707,892 issued to Kawagishi (the “Kawagishi patent”) or U.S. Patent No. 6,644,553 issued to Ohki et al. (the “Ohki patent”), and U.S. Patent No. 6,507,909 issued to Zurko et al. (the “Zurko patent”). It is respectfully asserted that the alleged combination of the Desai patent with any of the Kawagishi patent or the Ohki patent, along with the Zurko patent fails to teach or suggest the subject matter recited in amended independent claims 1, 8, 16, 23, 30, and 38, and the claims which depend therefrom.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103, not only must the prior art teach or suggest each element of the claim, the prior art must also suggest combining

the elements in the manner contemplated by the claim. *See Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 934 (Fed. Cir.), *cert. denied* 111 S.Ct. 296 (1990); *see In re Bond*, 910 F.2d 831, 834 (Fed. Cir. 1990). "It is improper to use the inventor's disclosure as a road map for selecting and combining prior art disclosures." *See Grain Processing Corp. v. American Maize-Products Corp.*, 840 F.2d 902, 907 (Fed. Cir. 1988). "[T]he reference must be viewed without the benefit of hindsight afforded to the disclosure." *In re Paulsen*, 30 F.3d 1475, 1482 (Fed.Cir. 1994). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. *See In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

A. Claims 1-7 and 23-29

Applicants' invention, as recited in amended independent claim 1, relates to a method for downloading an application to a card terminal which comprises, *inter alia*, receiving from the remote network connection a request to download an application to a card terminal, **monitoring the card terminal to detect at least one activity being performed at the card terminal, and upon detecting the activity being performed at the card terminal, electronically transmitting to the card terminal information related to the request for use in downloading the application to the card terminal.** Amended independent claim 23 is directed to an apparatus, and recites similar subject matter.

It is respectfully asserted that at least the recitations of monitoring a card terminal for at least one activity, and performing a function upon detection of such activity being performed at the card terminal are not taught or suggested by either the Desai patent, the Kawagishi, or the Ohki patents cited by the Examiner.

In the Office Action dated October 12, 2005, the Examiner attempts to further combine these references with the Zurko patent to teach or suggest this subject matter. It is asserted that the Zurko patent does not cure the deficiencies of the Desai, Kawagishi and Ohki patents to teach or suggest Applicants' claimed invention recited in amended independent claims 1 and 23. The Zurko patent relied on by the Examiner relates to security features of a computer system involving the use of a "secure-attention key." The Zurko patent describes a method for allowing secure access to a computing system from a terminal. Specifically, the Zurko patent provides for monitoring of terminal activity, and opening a trusted path (i.e., granting secure access to the computer system) upon the activation of a "secure attention key." (See Zurko patent, column 4, line 66 through column 5, line 7; column 7, lines 58-62; and column 8, line 54 through column 9, line 4.)

In contrast, amended independent claims 1 and 23 of the present application recite the monitoring at a remote card terminal and the transmission of information related to the request to download an application to the card terminal upon detection of at least one activity at the card terminal, and not opening of a secure connection between the remote network connection and the card terminal. The recited monitoring step can for example enable, *inter alia*, the reconfiguration or facilitation of data to a card terminal at an appropriate time, as discussed in the specification at page 19, line 3 through page 20, line 14. It is respectfully asserted that such recited subject matter of amended independent claims 1 and 23 are not taught or suggested by the Zurko patent, either by itself or in combination with the other references relied on by the Examiner.

B. Claims 8-15 and 30-37

Applicants' invention, as recited in amended independent claim 8, recites a method for providing configuration data to a card terminal, which comprises, *inter alia*, **monitoring the card terminal to detect at least one activity being performed at the card terminal, and electronically transmitting the configuration data to the card terminal upon detection of the activity being performed at the card terminal** in order to reconfigure the card terminal. Amended independent claim 30 is directed to an apparatus, and recites similar subject matter.

It is respectfully asserted that at least the recitations of monitoring a card terminal for at least one activity, and transmitting configuration data upon detection of such activity being performed at the card terminal, are not taught or suggested by either the Desai patent, the Kawagishi, or the Ohki patents cited by the Examiner.

Again, in the Office Action dated October 12, 2005, the Examiner attempts to further combine these references with the Zurko patent to teach or suggest this subject matter. It is asserted that the Zurko patent does not cure the deficiencies of the Desai, Kawagishi and Ohki patents to teach or suggest Applicants' claimed invention recited in amended independent claims 8 and 30. The Zurko patent describes a method of allowing secure access to a computing system from a terminal, as noted above.

In contrast, amended independent claims 8 and 30 of the present application recite the monitoring at a remote card terminal and the transmission of configuration data to the card terminal upon detection of at least one activity at the card terminal, and not any opening of a secure connection between the remote network connection and the card terminal. The monitoring recited in these claims can be used, for example, to enable, *inter alia*, the reconfiguration or providing of data to a card terminal to be performed at an appropriate time, as

described in the specification of the present application at page 19, line 3 through page 20, line 14. Thus, it is respectfully asserted that at least these recitations of amended independent claims 8 and 30 are not taught or suggested by the Zurko patent, either taken alone or in combination with the other references relied on by the Examiner.

C. Claims 16-22 and 38-44

Applicants' invention, as recited in amended independent claim 16 recites a method for providing information regarding activity at a card terminal via a network, which comprises, *inter alia*, **monitoring the card terminal to detect at least one activity being performed at the card terminal, generating information relating to the activity upon detection of the activity being performed at the card terminal** for network transmission and display, and transmitting the information to a user at a remote network connection. Amended independent claim 38 is directed to an apparatus, and recites similar subject matter.

It is respectfully asserted that at least the recitations of monitoring a card terminal, detecting a specific activity being performed at the card terminal, generating information relating to the activity, and transmitting the information to a user at a remote network connection, are not taught or suggested by either the Desai patent, the Kawagishi, or the Ohki patents cited by the Examiner.

Further, in the Office Action dated October 12, 2005, the Examiner attempts to combine these references with the Zurko patent to teach or suggest this subject matter. It is asserted that the Zurko patent does not cure the deficiencies of the Desai, Kawagishi and Ohki patents to teach or suggest Applicants' claimed invention recited in amended independent claims 8 and 30. The Zurko patent describes a method of allowing secure access to a computing system from a terminal, as noted above.

In contrast, amended independent claims 16 and 38 of the present application recite the monitoring of activity at a remote card terminal and, upon detection of at least one activity at the card terminal, the generation and transmission relating to that activity to a user at a remote network location, but not the opening of a secure connection between the remote network connection and the card terminal as described in the Zurko patent. For example, Applicants' monitoring recited in these claims can be used, for example, to enable, *inter alia*, the generation and transmission of information to be done at an appropriate time, as described in the specification of the present application at page 19, line 3 through page 20, line 14. It is respectfully asserted that at least these recitations of amended independent claims 16 and 38 are not taught or suggested by the Zurko patent, either taken alone or in combination with the other references relied on by the Examiner.

D. Summary

Therefore, Applicants respectfully submit that the alleged combination of the Desai patent with any of the Kawagishi patent or the Ohki patent, and together with the Zurko patent fails to teach or suggest the subject matter recited in amended independent claims 1, 8, 16, 23, 30 and 38. Claims which depend from independent claims 1, 8, 16, 23, 30 and 38 are also not taught or suggested by the alleged combination of the Desai patent with any of the Kawagishi patent or the Ohki patent, and with the Zurko patent for at least the same reasons. Thus, withdrawal of the rejection of these claims under 35 U.S.C. § 103(a) is respectfully requested.

III. REJECTION UNDER 35 U.S.C. § 112 SHOULD BE WITHDRAWN

Claims 8 and 30 stand rejected under 35 U.S.C. § 112, second paragraph, as being allegedly indefinite. As the Examiner shall ascertain, independent claims 8 and 30 have been amended to address the Examiner's comments but not for any reason relating to patentability

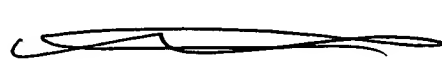

thereof. For example, the recited term "can be" has been amended from these claims. Thus, withdrawal of the rejection of these claims under 35 U.S.C. § 112, second paragraph, is respectfully requested.

IV. CONCLUSION

In view of the above, it is respectfully submitted that pending claims 1-53 are in condition for allowance. Prompt consideration, reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

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Gary Abelev
Patent Office Reg. No. 40,479

Steven P. Marsh
Patent Office Reg. No. 53,271

DORSEY & WHITNEY, L.L.P.
250 Park Avenue
New York, New York 10177

Attorneys for Applicants
(212) 415-9371